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LEGAL ISSUES



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Legally Speaking — Databases, *Tasini* and the Information Age

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Dateline 2000—as the century changes, information is readily accessible via databases. Beginning with such tools as Dialog, Lexis-Nexis, and Westlaw in the 1970s, computer research has become an integral part of the research process. This process has been accelerated by the release of the World Wide Web in the 1990s. Articles from newspapers and magazines are readily accessible. The information world is here!

Dateline 2001—The world has changed. Database vendors are notifying their customers that they are unable to provide access to newspaper and magazine backfiles. Only current articles are available. Librarians and publishers are at each others' throats. The information age is in doubt! Why this drastic change? The case of *Tasini v. New York Times Co.*¹

So what is *Tasini* all about? The case revolves around the definition of "collective works" under the copyright laws. According to copyright law, "A 'collective work' is a work, such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole."² Once the collective work is completed, the article writers retain copyright to their work. On the other hand, the entire work itself has a separate copyright, usually owned by the publisher.³

For example, a magazine might be made up of separate articles by different authors. Copyright in the articles themselves is owned by the individual authors. Copyright for the magazine as a whole is owned by the publisher. The work as a whole is a "compilation" under copyright law. Compilations are formed by collecting and assembling preexisting works together. "[T]he resulting work as a whole constitutes an original work of authorship. The term 'compilation' includes collective works."⁴

On the other hand, a "derivative work" comes about when one work becomes the basis upon which another one is built. For example, the novel *Gone with the Wind* be-

came the movie "Gone with the Wind." Who owns the copyright? According to the statute, the rights to the movie are owned by the studio, but the rights to the novel are still owned by the estate of **Margaret Mitchell**. At the same time, **Margaret Mitchell** does have *some* measure of rights in the movie version of her book.⁵

In the *Tasini* case, six free-lance authors sold their works to various newspapers and magazines, including *The New York Times*, *Newsday*, and *Sports Illustrated*.⁶ The publishers in turn licensed the articles to Lexis-Nexis and to UMI's *New York Times OnDisc*.⁷ Since these kinds of transactions have become increasingly common over the last 20 years (leading to the so-called "Information Revolution"), this sounds like a routine transaction that should cause no problems. However, the plaintiffs in the *Tasini* case have pointed out that there are still many unanswered questions.⁸

The basis of the *Tasini* claim is that the publishers had no right to license their work for database inclusion. According to the authors, only the author of an article may license its subsequent use. The authors claim that the publishers are not authorized to license the authors' work. The authors are free-lance writers, and their work does not constitute "work-for-hire."⁹

The authors are basing their claim on section 103 of the copyright law.¹⁰ According to section 103, "The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material."¹¹

The issues in the *Tasini I* case revolved

around whether the databases constitute "revisions" of the original works,¹² since both collective works and derivative works are based upon other works that are already copyrighted.¹³ According to one analysis of the *Tasini I* case, "At issue in this case are the limits of copyright extended to the authors of the constituent parts, and to the author of the collective work, usually the publisher.

Juxtaposed between these rights is the impact of "electronic media" on the rights of both authors and publishers."¹⁴

Derivative works transform the preexisting works into a new creation. A collective work includes "numerous original contributions which are not altered, but which are assembled into an original collective whole. In both instances, the copyright law accounts for the fact that the larger work—although it is entitled to copyright protection -- consists of independent original contributions which are themselves protected."¹⁵

(Citations omitted) *868 [FN39]

In order for a compilation to become an independent work, the compiler's effort must be more than minimal or trivial. "Originality in the context of compilations can consist of selectivity, or independent original effort in collecting, assembling, selecting, organizing, arranging, and compiling the pre-existing materials."¹⁶ For example, "a compilation of selected scenes from movies featuring a particular actor has been held to constitute a protectable work under the Copyright Act, to the extent that the creator exercised skill and creativity in selecting and arranging the scenes."¹⁷

The authors' claim is based in part on the legislative history of the 1976 Copyright Act. According to legislative history, "Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could re-

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print an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.¹⁸ The authors concede that microfilm is an acceptable means of displaying the compilation, but maintain that inclusion in an electronic database constitutes an entirely new work which they have not given permission for.¹⁹

The *Tasini I* court did not buy this argument. In fact, the court found that the microform concession was particularly damning to the authors' case.²⁰ According to the opinion, the publishers have 'reproduction' rights for collective works, and "reproductions result in copies. . . . 'Copies' are material objects. . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device . . . 17 U.S.C. '101. Thus, the right to reproduce a work, which necessarily encompasses the right to create copies of that work, presupposes that such copies might be 'perceived' from a computer terminal."²¹

Finding that the authors did not have a material issue of law, the District Court in *Tasini I* granted summary judgment to the defendants. The Second Circuit reversed the grant of summary judgment. Basically, the *Tasini II* court felt that aggregation of articles into a database did not comprise a revision of the work. According to the opinion, "If the disputed periodicals manifest an original selection or arrangement of materials, and if that originality is preserved electronically, then the electronic reproductions can be deemed permissible revisions of the publisher defendants' collective works. If, on the other hand, the electronic defendants do not preserve the originality of the disputed publications, but merely exploit the component parts of those works, then plaintiffs' rights in those component parts have been infringed."²²

The *Tasini II* court felt that there was no "revision" in the preparation of a database; however, since the original formatting was lost, the database does not constitute a copy of the original publication. It was significant that articles are retrieved "according to criteria unrelated to the particular edition in which the articles first appeared."²³

The court relied on 17 U.S.C. '201(c) for support. The language in '201(c) describes a collective work as including a periodical issue.²⁴ An article written for one issue can not be included in another issue without a new grant of rights by the author. The court therefore questions why a database is different. Since publishers can't sell articles directly to the public, even if all the articles from an issue were sold, "We see nothing in the revision provision that would allow the Publishers to achieve the same goal indirectly through NEXIS. . . . [I]t is significant that neither the Publishers nor NEXIS evince any intent to compel, or even to permit, an end user to retrieve an indi-

vidual work only in connection with other works from the edition in which it ran. Quite the contrary, *The New York Times* actually forbids NEXIS from producing 'facsimile reproductions' of particular editions. What the end user can easily access, of course, are the preexisting materials that belong to the individual author under Sections 201(c) and 103(b)."²⁵

At the same time that *Tasini* is being litigated in the courts, librarians are concerned about database costs and access to information. Authors want the rights to

their works. Publishers want to be able to license to database companies. All of these parties want to charge for use. On the other hand, librarians just want access to the information. Like the authors, librarians and database vendors sometimes feel as if publishers are making windfall profits on the electronic rights to articles. The high cost of electronic re-publication is causing database companies to raise their prices. The high cost of databases means that libraries have difficulty subscribing.

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Endnotes

1. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 1997 U.S. Dist. LEXIS 11988, *Copy. L. Rep. (CCH)* P27672, 25 *Media L. Rep. (BNA)* 2057, 43 U.S.P.Q.2d (BNA) 1801 (S.D.N.Y. 1997). This case will be referred to as "*Tasini I*."
- Reconsideration denied by *Tasini v. New York Times Co.*, 981 F. Supp. 841, 1997 U.S. Dist. LEXIS 17140 (S.D.N.Y. 1997).
- Reversed and Remanded by *Tasini v. New York Times Co.*, 192 F.3d 356, 1999 U.S. App. LEXIS 23360, 27 *Media L. Rep. (BNA)* 2281, 52 U.S.P.Q.2d (BNA) 1186 (2d Cir. N.Y. 1999).
- Opinion withdrawn by Court and replaced by *Tasini v. New York Times Co.*, 206 F.3d 161, 1999 U.S. App. LEXIS 36241, 28 *Media L. Rep. (BNA)* 1748, 54 U.S.P.Q.2d (BNA) 1032 (2d Cir. N.Y. 1999). This case will be referred to as "*Tasini II*."
- *Writ of certiorari* granted by *New York Times Co. v. Tasini*, 148 L. Ed. 2d 434, 121 S. Ct. 425, 2000 U.S. LEXIS 7321, 69 U.S.L.W. 3316, 2000 Cal. Daily Op. Service 8896, 2000 D.A.R. 11808 (U.S. 2000)
2. For related proceeding, see also, *Marx v. Globe Newspaper Co.*, 2001 Mass. Super. LEXIS 9 (Mass. Super. Ct. Jan. 11, 2001).
3. 17 U.S.C.A. '101
4. 17 U.S.C.A. '201(c)
5. 17 U.S.C.A. '101
6. "A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'" 17 U.S.C. '101(3).
7. *Tasini I* at 806.
8. *Tasini I* at 806.
9. "At the dawn of a new millennium, the United States is in the midst of unprecedented technological change in which our capacity to produce, transmit, and receive information increases daily. The electronic media . . . have redefined the ways in which consumers acquire this information. As communicative technology grows, conflicts over ownership of creative content are inevitable, giving rise to the need to reevaluate the rules of ownership of intellectual property in the modern environment of electronic publishing." Robert Meitus, Note, "Interpreting the Copyright Act's Section 201(c) Revision Privilege With Respect to Electronic Media," 52 *Federal Communications Law Journal* 749, 750 (May, 2000). See Also, Dom F. Atteritano, Note, "The Growing Financial Pie of Online Publication: *Tasini*'s New-Use Analysis Leaves Freelance Authors less than crumbs," 27 *Hofstra Law Review* 377 (Winter 1998); Michael Spink, Comment, "Authors Stripped of their Electronic Rights in *Tasini v. New York Times Co.*," 32 *John Marshall Law Review* 409 (Winter 1999).
10. The copyright law states that "In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright." 17 U.S.C. '201(b).
11. 17 U.S.C. '103.
12. 17 U.S.C. '103.
13. *Tasini I* at 812.
14. *Tasini I* at 812, Quoting 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* '3.02, at 3-8 (1996 ed.).
15. Michael A. Forhan, Note, "Tasini v. New York Times: The Write Stuff for Copyright Law?" 27 *Capital University Law Review* 863, 868 (1999). See Also, Alice Haemmerli, Commentary, "Tasini v. New York Times Co. Symposium on Electronic Rights in International Perspective," 22 *Columbia-VLA Journal of Law and the Arts* 129 (Winter, 1998); Dina Marie Pascarella, Casenote, "Electronic Rights: After *Tasini* who owns that, when? *Tasini v. New York Times*," 8 *DePaul-LCA Journal of Art and Entertainment Law* 45 (Fall, 1997).
16. *Tasini I* at 812.
17. David E. Rigney, "What Constitutes a 'Compilation' Subject to Copyright Protection—Modern Cases," 88 *A.L.R. Fed.* 151.
17. 88 *A.L.R. Fed.* 151, referencing *Broderbund Software, Inc. v. Unison World, Inc.* (1986, ND Cal) 648 F Supp 1127, 231 U.S.P.Q. 700.
18. H.R. Report No. 94-1476, at 122-23 (1976), *U.S. Code Cong. & Administrative News* 1976, p. 5738. Quoted in *Tasini I* at 817.
19. *Tasini I* at 816.
20. *Tasini I* at 816.
21. *Tasini I* at 816.
22. *Tasini I* at 822.
23. *Tasini II* at 169.
24. 17 U.S.C. '201(c).
25. *Tasini II* at 167-169.
26. Linton Weeks, "Pat Schroeder's New Chapter: The Former Congresswoman Is Battling For America's Publishers," *Washington Post*, February 7, 2001, at C1.
27. *id.*
28. *id.*
29. *id.*
30. Posting of Felice Lowell, Assistant Director for Technical Services, Cleveland-Marshall College of Law Library, to <Law-lib@ucdavis.edu>, Re: "Pat Schroeder wants to fight librarians," (February 7, 2001).

Where these groups diverge from the authors' position is on the issue of charging. The authors want a piece of the publishers' pie, but the database vendors and librarians want materials to be more readily accessible without the high cost of buying re-publication rights. This has especially pitted librarians against publishers. In fact, "Of all the dangerous and dot-complex problems that American publishers face in the near future -- economic downturns, competition for leisure time, piracy -- perhaps the most explosive one could be libraries. Publishers and librarians are squaring off for a battle royal over the way electronic books and journals are lent out from libraries and over what constitutes fair use of written material."²⁶

According to former Congresswoman **Pat Schroeder**, who is now the president of the **Association of American Publishers (AAP)**, "Publishers have to figure out a way to charge for electronic material [since] markets are limited. One library buys one of their journals. . . They give it to other libraries. They'll give it to others."²⁷ The **AAP** is concerned about such traditional library functions as inter-library loan, lending to patrons, and printing. Libraries respond by saying that printing an e-journal is not any different than photocopying a paper article. Ironically, some of the arguments that librarians use with publishers are the same ones that publishers used in *Tasini*.


According to **Nancy Kranich**, president of the **American Library Association**, "The reason we're in a bind is that the price of some of the materials has skyrocketed, without any explanation. . . The publishing community does not believe that the public should have the same

rights in the electronic world."²⁸ One example that Kranich used was the chemistry journal *Tetrahedron Letters*, which costs \$14,000 a year.²⁹ Computer databases can be even more expensive.

According to some, the publishers created their own problem when "they forced libraries to purchase online [subscriptions] for the public, keep the paper which still has to be processed and archived, and then had the gall to charge us more if we eliminated the paper copy."³⁰

At this point, it is clear that something needs to be done. The problem is to decide how to make changes that will be ac-

ceptable to everyone. Authors need to be paid. Publishers need to be able to re-publish their collective works. Database vendors need materials to present online, while libraries need publications and databases that are affordable and accessible. The U.S. Supreme Court will decide *Tasini*, but since this is only a request for summary judgment the case could drag on for years.

I don't have the answers, but hopefully we will find the solution soon. All of the players in the process are talking, and that is the best hope for resolution. After all, we all have a stake in keeping the Information Age going. 

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Copyright Corner — Importance of the Public Domain

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What is the public domain and why is it important in copyright law? Nearly everyone has heard the term and has at least a vague notion of why it is important, but a deeper understanding of the value of the public domain is important for librarians, especially as copyright holders try to expand their rights.

A shorthand definition of a "public domain" work is that the work is the opposite of a copyrighted work. Works that are copyrighted have a bundle of rights associated with them. The owner of the copyright has the exclusive right to reproduce and distribute the work, adapt it, publicly perform and display

it and, if the work is a sound recording, to publicly perform it by digital means. If the work is within the public domain, there are no ownership rights associated with the work. It may be said that everyone and no one owns the work. Therefore, anyone may reproduce the work, distribute it, adapt it, etc.

The public domain is particularly important to scholars, researchers and librarians. There is no longer any need to seek permission for any uses of the work, so members of the public may freely use public domain works, not only for nonprofit educational and library purposes but also for research, scholarship and even to commercially exploit the

work. The statute does not define public domain. Instead, it details the conditions necessary for copyright protection, the types of works that are eligible for protection, the rights of copyright holders and the exceptions to these exclusive rights. Thus, a work not protected by copyright is necessarily a public domain work. One of the major complaints from the scholarly and research communities about term extension¹ was that adding an additional 20 years to the term of copyright for existing works delayed by two decades works passing into the public domain. In fact, it will be 2019 before any-

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